REMARKS:

Entry of the foregoing and reexamination and reconsideration of the Application, as amended, and in light of the remarks that follow are respectfully requested.

Claims 1 and 3-53 are pending in the Application. Claim 2 is cancelled by present amendment. Claims 1-53 have been rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent 5,574,828 to Hayward et al. (Hayward). Claim 15 has furthermore been objected to as being unclear.

The instant amendment and response amends claims 1, 15, 16, 29, 31, 40, and 50. Claims 1, 16, 29, 40, and 50 are amended to clarify that a "basic question set" and "re-optimized" or "updated" basic question set represent the "minimum number of questions that must be answered to comply with the regulatory criteria." Claim 15 is amended to clarify the particular question to which it applies. Claim 31 is additionally amended to correct an inadvertent typographical error.

The Applicants submit that the present amendments contain no new subject matter and are supported in the original specification. The Applicants respectfully request reconsideration of the subject application in light of the foregoing amendments and the following remarks.

I.   *Claim Objections*

Claim 15 stands objected to because of an alleged informality, in that claim 15 recites "basic question set question." The Office Action states that it appears the phrase should read "basic question set." Applicants respectfully disagree and amend claim 15 in a further attempt to clarify.

The recitation of "basic question set question" is an attempted shorthand for a *basic question from* the basic question set, *not* the "basic question set" itself. Applicants nonetheless understand the Office's confusion and by present amendment amends claim 15 to recite "basic question." While the amendment to claim 15 has not changed its meaning from the original, claim 15 as amended more clearly recites "the at least one *basic question.*"

Thus, Applicants respectfully submit that claim 15 as amended is allowable and the objection should be withdrawn.

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II. *Rejections Under 35 U.S.C. § 102 -- U.S. Patent No. 5,574,828 to Hayward*

Claims 1 and 3-53 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,574,828 to Hayward et al. (Hayward). The Applicants respectfully traverse this rejection.

A. Hayward Does Not Disclose, Suggest, or Teach Claim 1 of the Present Invention

1. Claim 1

Claim 1 as amended requires, *inter alia*, "determining from the overall question set a basic question set, the basic question set including at least one basic question, wherein the at least one basic question comprises the minimum number of questions that must be answered to comply with the regulatory criteria." It can be seen from claim 1 that the goal of the present application is to provide a user with the *minimum* number of questions while satisfying relevant regulatory criteria. As described in more detail in the specification, regulatory criteria such as the USA PATRIOT Act may require financial institutions to obtain certain information about their customers. Application, paragraphs [0026] and [0027]. However, not all customers require the same questions. The present invention "provides methods of obtaining customer information that tailor themselves to the characteristics of the customer as information on those characteristics is received."

It is this iterative act of revising the question set asked of the customer after every unexpected answer that provides a system that minimizes the amount of questions that *must* be asked in order to abide by certain regulatory criteria.

2. The Hayward Patent

Hayward is directed to an expert system for use in situations where a qualification decision or next course of action determination must be made. For example, Hayward discloses a program where various attributes and conditions of a patient are entered such that the system may determine potential diagnoses. Hayward, col. 7, lines 37-52. In providing such questions, Hayward does take into account regulatory criteria, noting that "some questions may be dictated by law while others may be deemed impermissible by law." Hayward, col. 5, lines 37-39.

3. Hayward Does Not Disclose, Suggest or Teach Claim 1

However, Hayward does not disclose, suggest, or teach claim 1 of the present invention. Hayward fails to teach or disclose any form of *minimizing* the question set as it is being asked.

The Office Action references col. 5, lines 34-43 of Hayward, which describes that "in a federal regulatory environment, some questions may be dictated by law while others may be deemed impermissible by law." Regulatory criteria obviating questions deemed impermissible by law is not the same thing as minimizing the number of questions. Obviating such impermissible questions may, at most, *reduce* the number of questions, but it does not *minimize* the number of questions.

Hayward does note that "[t]he system of the present invention automatically narrows the field and presents only a necessary list of *second* questions for each applicant." Hayward, col. 5, lines 39-43 (emphasis added). Claim 1, however, does not provide for a *second* list of questions. Instead, claim 1 as amended recites an iterative process that recalculates the questions necessary to satisfy regulatory criteria each time an unexpected answer is received.

Claim 1 as amended goes even further than merely minimizing the number of questions. First, claim 1 as amended recites the "at least one basic question represents the minimum number of questions that must be answered to comply with the regulatory criteria," i.e., the number of questions if all expected answers are given. Second, claim 1 as amended recites "the criteria are structured to minimize the number of remaining questions that must be answered in order to comply with the regulatory criteria," and further, "the basic question set is modified according to the criteria each time an answer is received that differs from the expected answer." Thus, if an answer other than an expected answer is given, the basic question set is modified to minimize the number of remaining questions that must be answered in order to comply with the regulatory criteria.

Hayward fails to disclose, teach or suggest the required elements of claim 1. Because Hayward does not teach, disclose or suggest the features of claim 1, the Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. 102(b) be withdrawn.

B.   Hayward Does Not Disclose, Teach, or Suggest Claims 3-15

Applicants submit that claims 3-15 are all dependent on claim 1, which has been shown to be patentable over the cited reference. The Applicants therefore submit that claims 3-15 must also be patentable over Hayward and therefore respectfully request that the rejection of claims 3-15 under 35 U.S.C. 102(b) be withdrawn.

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C.   Hayward Does Not Disclose, Teach, or Suggest Claim 16 of the Present Invention

1.   Claim 16

Claim 16 as amended recites *inter alia,* "wherein the at least one question comprises the minimum number of questions for which answers are required in order to comply with the regulatory criteria" and "the optimum question set having a minimum number of questions required for compliance with the regulatory criteria based on the answer to the selected question."

2.   The Hayward Patent

As discussed in more detail above in regards to independent claim 1, the Hayward Patent is generally directed to an expert system for use in situations where a qualification decision or next course of action determination must be made. Hayward, col. 7, lines 37-52. In providing such questions, Hayward takes into account regulatory criteria, noting that "some questions may be dictated by law while others may be deemed impermissible by law." Hayward, col. 5, lines 37-39.

3.   Hayward Does Not Disclose, Teach or Suggest Claim 16

As an initial matter, Applicants respectfully submit that the Office's statement that "[c]laims 16-53 recite substantially similar subject matter to claims 1-15…[and] are rejected on the same basis as claims 1-15 above" is an impermissible omnibus rejection under MPEP § 707.07(d). Applicants note that this statement applies equally to independent claims 29, 40, and 50. However, assuming *in arguendo,* that such rejections are proper, Applicants respond as follows.

Hayward does not disclose, suggest, or teach claim 16 of the present invention. Hayward fails to teach or disclose any form of *minimizing* the question set as it is being asked. The Office Action references col. 5, lines 34-43 of Hayward, which describes that "in a federal regulatory environment, some questions may be dictated by law while others may be deemed impermissible by law." Regulatory criteria obviating questions deemed impermissible by law is not the same thing as minimizing the number of questions. Obviating such impermissible questions may, at most, *reduce* the number of questions, but it does not *minimize* the number of questions.

Hayward does note that "[t]he system of the present invention automatically narrows the field and presents only a necessary list of *second* questions for each applicant." Hayward, col. 5, lines 39-43 (emphasis added). Claim 16, however, does not provide for a *second* list of

questions; rather claim 16 provides the user with a single set of questions, optimized to minimize the amount of questions asked based on each previous answer. In other words, claim 16 recites an iterative process that recalculates the questions necessary to satisfy regulatory criteria each time an unexpected answer is received.

Claim 16 as amended goes even further than merely minimizing the number of questions. For example, claim 16 establishes an "optimum question set having a minimum number of questions required for compliance with the regulatory criteria based on the answer to the selected question..." This optimum question set is re-established every time an answer is received that "differs from the single expected answer associated with the selected question."

Hayward does not disclose this iterative process of providing a user with a single, constantly updated, question set that complies with specified criteria. Rather, Hayward merely discloses a system that "automatically narrows the field and presents only a necessary list of second questions for each applicant." The act of narrowing a field, and providing additional questions that may be required to meet specified regulatory criteria are antithetical goals.

Hayward fails to disclose, teach or suggest the required elements of claim 16. Because Hayward does not teach, disclose or suggest the features of claim 16, the Applicants respectfully request that the rejection of claim 16 under 35 U.S.C. 102(b) be withdrawn.

D.   Hayward Does Not Disclose, Teach, or Suggest Claims 17-28

Applicants submit that claims 17-28 are all dependent on claim 16, which has been shown to be patentable over the cited reference. The Applicants therefore submit that claims 17-28 must also be patentable over Hayward and therefore respectfully request that the rejection of claims 17-28 under 35 U.S.C. 102(b) be withdrawn.

E.   Hayward Does Not Disclose, Teach, or Suggest Claim 29 of the Present Invention
1.   Claim 29

Claim 29 as amended recites *inter alia,* "wherein the optimized set of questions represents the minimum number of questions for which answers are required in order to comply with the regulatory criteria, the answers to which would be sufficient to meet the regulatory criteria if no unexpected answers are received," and further, "wherein the re-optimized set of

questions represents the minimum number of questions, the answers to which would be sufficient to meet the regulatory criteria if no further unexpected answers are received."

2. The Hayward Patent

As discussed in more detail above in regards to independent claim 1, the Hayward Patent is generally directed to an expert system for use in situations where a qualification decision or next course of action determination must be made. Hayward, col. 7, lines 37-52. In providing such questions, Hayward takes into account regulatory criteria, noting that "some questions may be dictated by law while others may be deemed impermissible by law." Hayward, col. 5, lines 37-39.

3. Hayward Does Not Disclose, Teach, or Suggest Claim 29

Hayward does not disclose, suggest, or teach claim 29 of the present invention. Hayward fails to teach or disclose any form of *minimizing* the question set as it is being asked. The Office Action references col. 5, lines 34-43 of Hayward, which describes that "in a federal regulatory environment, some questions may be dictated by law while others may be deemed impermissible by law." Regulatory criteria obviating questions deemed impermissible by law is not the same thing as minimizing the number of questions. Obviating such impermissible questions may, at most, *reduce* the number of questions, but it does not *minimize* the number of questions.

Hayward does note that "[t]he system of the present invention automatically narrows the field and presents only a necessary list of *second* questions for each applicant." Hayward, col. 5, lines 39-43 (emphasis added). Claim 29, however, does not provide for a *second* list of questions; rather claim 29 provides the user with a single "optimized set of questions," that comprises "the minimum number of questions the answers to which would be sufficient to meet the regulatory criteria if no further unexpected answers are received." In other words, claim 29 recites an iterative process that recalculates the questions necessary to satisfy regulatory criteria each time an unexpected answer is received.

Hayward does not disclose this iterative process of providing a user with a single, constantly updated, question set that complies with specified criteria. Rather, Hayward merely discloses a system that "automatically narrows the field and presents only a necessary list of second questions for each applicant." The act of narrowing a field, and providing additional questions that may be required to meet specified regulatory criteria are antithetical goals.

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Hayward fails to disclose, teach or suggest the required elements of claim 29. Because Hayward does not teach, disclose or suggest the features of claim 29, the Applicants respectfully request that the rejection of claim 29 under 35 U.S.C. 102(b) be withdrawn.

F.   Hayward Does Not Disclose, Teach, or Suggest Claims 30-39

Applicants submit that claims 30-39 are all dependent on claim 29, which has been shown to be patentable over the cited reference. The Applicants therefore submit that claims 30-39 must also be patentable over Hayward and therefore respectfully request that the rejection of claims 30-39 under 35 U.S.C. 102(b) be withdrawn.

G.   Hayward Does Not Disclose, Teach, or Suggest Claim 40 of the Present Invention

1.   Claim 40

Claim 40 as amended recites *inter alia,* "wherein the optimized question set represents the minimum number of questions that must be answered to comply with the regulatory criteria, and wherein the question optimization module is adapted to modify the optimized question set after receiving answers from the user that differ from the expected answer to include the minimum number of remaining questions that must be answered in order to comply with the regulatory criteria."

2.   The Hayward Patent

As discussed in more detail above in regards to independent claim 1, the Hayward Patent is generally directed to an expert system for use in situations where a qualification decision or next course of action determination must be made. Hayward, col. 7, lines 37-52. In providing such questions, Hayward takes into account regulatory criteria, noting that "some questions may be dictated by law while others may be deemed impermissible by law." Hayward, col. 5, lines 37-39.

3.   Hayward Does Not Disclose, Teach, or Suggest Claim 40

Hayward does not disclose, suggest, or teach claim 40 of the present invention. Hayward fails to teach or disclose a system that provides an *optimized* question set that "comprises the minimum number of questions that must be answered to comply with the regulatory criteria." The Office Action references col. 5, lines 34-43 of Hayward, which describes that "in a federal regulatory environment, some questions may be dictated by law while others may be deemed

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impermissible by law." A system that utilizes regulatory criteria to obviate questions deemed impermissible by law is not the same thing as a system that minimizes the number of questions and presents a user with an optimized question set. Obviating such impermissible questions may, at most, *reduce* the number of questions, but it does not *minimize* the number of questions.

Moreover, Hayward does not disclose, teach, or suggest a system that optimizes the question set "after receiving answers from the user that differ from the expected answer." Hayward does note that "[t]he system of the present invention automatically narrows the field and presents only a necessary list of *second* questions for each applicant." Hayward, col. 5, lines 39-43 (emphasis added). Claim 40, however, does not provide for a system that displays or provides a *second* list of questions to a user; rather the system of claim 40 provides the user with a single "optimized question set," that comprises "the minimum number of questions that must be answered to comply with the regulatory criteria."

Hayward does not disclose a system that provides a user with a single, constantly updated, question set that complies with specified criteria. Rather, Hayward merely discloses a system that "automatically narrows the field and presents only a necessary list of second questions for each applicant."

Hayward fails to disclose, teach or suggest the required elements of claim 40. Because Hayward does not teach, disclose or suggest the features of claim 40, the Applicants respectfully request that the rejection of claim 40 under 35 U.S.C. 102(b) be withdrawn.

H.   Hayward Does Not Disclose, Teach, or Suggest Claims 41-49

Applicants submit that claims 41-49 are all dependent on claim 40, which has been shown to be patentable over the cited reference. The Applicants therefore submit that claims 41-49 must also be patentable over Hayward and therefore respectfully request that the rejection of claims 41-49 under 35 U.S.C. 102(b) be withdrawn.

I.   Hayward Does Not Disclose, Teach, or Suggest Claim 50 of the Present Invention
        1.   Claim 50

Claim 50, as amended, recites *inter alia,* a computer readable medium for compiling a customer information set "wherein the at least one question represents the minimum number of questions that must be answered to comply with the regulatory criteria" and "the optimum

question set having a minimum number of questions required for compliance with the regulatory criteria based on the answer to the selected question."

2. The Hayward Patent

As discussed in more detail above in regards to independent claim 1, the Hayward Patent is generally directed to an expert system for use in situations where a qualification decision or next course of action determination must be made. Hayward, col. 7, lines 37-52. In providing such questions, Hayward takes into account regulatory criteria, noting that "some questions may be dictated by law while others may be deemed impermissible by law." Hayward, col. 5, lines 37-39.

3. Hayward Does Not Disclose, Teach, or Suggest Claim 50

Claim 50 is directed to a computer readable medium for compiling a customer information set that complies with regulatory criteria. As noted above, claim 50 as amended requires "displaying at least one question having an associated single expected answer...wherein the at least one question comprises the minimum number of questions that must be answered to comply with the regulatory criteria." Hayward does not disclose, teach, or suggest this element.

Hayward discusses regulatory criteria, noting that "in a federal regulatory environment, some questions may be dictated by law while others may be deemed impermissible by law." The Hayward Patent, col. 5, lines 34-43. As discussed numerous times above, a system that utilizes regulatory criteria to obviate questions deemed impermissible by law is not the same thing as a system that minimizes the number of questions and presents a user with an optimized question set. Obviating such impermissible questions may, at most, *reduce* the number of questions, but it does not *minimize* the number of questions.

It is this process of responding to unexpected answers by providing to a user a re-optimized question set comprising the minimum number of questions that must be answered to comply with regulatory criteria that the Hayward Patent fails to disclose. Hayward fails to disclose, teach or suggest the required elements of claim 50. Because Hayward does not teach, disclose or suggest the features of claim 50, the Applicants respectfully request that the rejection of claim 50 under 35 U.S.C. 102(b) be withdrawn.

J.   Hayward Does Not Disclose, Teach, or Suggest Claims 51-53

Applicants submit that claims 51-53 are all dependent on claim 50, which has been shown to be patentable over the cited reference. The Applicants therefore submit that claims 51-53 must also be patentable over Hayward and therefore respectfully request that the rejection of claims 51-53 under 35 U.S.C. 102(b) be withdrawn.

III.   Conclusion

For at least the reasons set forth above, the Applicants respectfully submit that claims 1 and 3-53 are in condition for allowance. The Applicants therefore request that the Application be allowed and passed to issue.

Should the Examiner believe anything further is desirable in order to place the Application in even better condition for allowance, the Examiner is invited to contact the Applicant's undersigned representative.

Respectfully submitted,

Dated: July 24, 2006
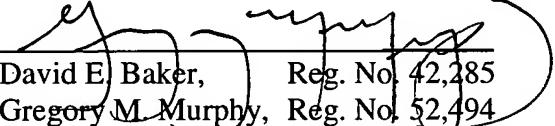
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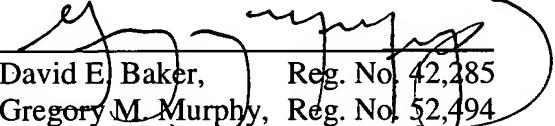
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